

REMARKS

By this Amendment, claims 1-3 have been amended merely to recite the claimed subject matter without narrowing the scope of any of the claims and new claims 4-20 have been added merely to add dependent claim support to the pending independent claims 1-3. Applicant has amended the currently pending claims in order to expedite prosecution and do not, by this amendment, intend to abandon subject matter of the claims as originally filed or later presented. Moreover, Applicant reserves the right to pursue such subject matter in a continuing application. No new matter has been added. New claims 4-20 find support in the application, including pages 6-19 of the specification and Figures 2-4. Each of the new dependent claims 4-20 depend, directly or indirectly, from pending independent claims 1-3, respectively. Claims 1-20 are pending in this patent application. Reconsideration of the rejections in view of the remarks below is requested.

The Examiner objected to the Abstract because it allegedly exceeds the limit of 150 words in length. Applicant has amended the Abstract to reduce the length and otherwise put the Abstract in better form. Accordingly, Applicant requests that the objection be withdrawn.

The Office Action rejected claim 2 under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regard as its invention. While Applicant believes the claim is definite already without amendment and does not agree with Examiner's limited reading of the claim, to expedite prosecution, Applicant has amended claim 2 to change the preamble. Applicant respectfully submits claim 2 as unamended would have properly been understood in the manner now amended by those skilled in the art and thus the amendment of claim 2 should not be seen as narrowing the scope of any of the claims.

The Office Action further rejected claim 2 under 35 U.S.C. §101 as allegedly being directed to non-statutory subject matter. In particular, Examiner argues that the preamble of claim begins with discussing a system and then allegedly improperly recites method steps in the body of the claim. Respectfully, Applicant fails to understand how claim 2 can be considered non-statutory subject matter. The preamble of claim 2 recites “[a] method for facilitating provision of a warranty relating to a transaction between two parties ... in a system ... [details of the system] ... , said method comprising ...” Respectfully, claim 2 is merely a method claim and the recitation of a system is merely to provide context for the method, namely it is a method for facilitating provision of a warranty relating to a transaction

between two parties in the system. Accordingly, Applicant requests that the rejection of claim 2 under 35 U.S.C. §101 be withdrawn.

Further, the Examiner rejected claims 1-3 under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 5,903,882 to Asay et al. (hereinafter “Asay”). Applicant respectfully traverses the rejection, without prejudice.

Applicant respectfully submits that the Office Action is not complete as to all matters because the Examiner has not clearly identified the grounds of rejection for claim 1.

Applicant points out that a plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group, *per MPEP 707.07(d)*. MPEP 707.07(d), first sentence, mandates that “where a claim is refused for any reason relating to the merits thereof … [its] ground of rejection [should be] fully and clearly stated”. (Emphasis added). Furthermore, MPEP 707.07(g), which also relates to the completeness and clarity of the Examiner’s action, mandates that “where a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression.” (Emphasis added). In its rejection of claim 1, the Examiner has not provided any explanation as to how the language of claim 1 is disclosed by Asay. Examiner has merely compared the claim language of claim 2 against Asay but has failed to set forth detailed reasons as to how the claim language of claim 1 is disclosed in Asay. Thus, in the event that claim 1 is not allowed, Applicant respectfully submits that a new, non-final Office Action must be issued setting a new period for reply and explaining how claim 1 is disclosed by Asay. See MPEP §706.07

Nevertheless, Applicant respectfully submits that the cited portions of Asay fail to disclose a system for providing a warranty relating to a transaction between two parties wherein, *inter alia*, each location comprises means for exchanging stored information with every other location, means for creating a warranty relating to either party to the transaction in response to a request received from at least one of the parties which is a client of the respective institution and based on information about the two parties contained in at least one of the databases and information about the nature of the transaction received from the one of the parties, and means for receiving information from the institution of the other party indicating whether that institution would support or not support the warranty as recited in independent claim 1.

For example, Asay et al. fails to disclose means for receiving information from the institution of the other party indicating whether that institution would support or not support the warranty. Asay simply discloses a system and a method utilizing a single institution, or

server. In contrast, the claimed system is configured to facilitate processing of a warranty in an infrastructure having a plurality of institutions to enable one institution to receive from another institution information indicating whether that institution would support or not support the warranty. So, for example, Asay assumes that a single server can be trusted by the parties to a transaction, whereas here a plurality of institutions are involved, each of which may be trusted by, or have a relation with, one party or another. Thus, the claimed system may resolve this trust issue by having one institution configured to receive from another institution information indicating whether that institution would support or not support the warranty.

Further, Applicant respectfully submits that the cited portions of Asay fail to disclose a method for facilitating provision of a warranty relating to a transaction between two parties comprising, *inter alia*, receiving a request for a warranty from one party to the transaction which is a client of the respective institution to a respective location associated with the respective institution, which request includes information identifying the other party to the transaction and information about the nature of the transaction; receiving information to the respective location from a location associated with an institution of which the other party is a client, the information indicating whether the institution of which the other party is a client would support or not support the warranty; and transmitting a response to the request from the respective location to the one party as recited in independent claim 2.

As similarly discussed above, for example, Asay et al. fail to disclose receiving information to the respective location from a location associated with an institution of which the other party is a client, the information indicating whether the institution of which the other party is a client would support or not support the warranty. Asay simply discloses a system and a method utilizing a single institution, or server. In contrast, the claimed method facilitates processing of a warranty in an infrastructure having a plurality of institutions to enable one institution to receive from another institution information indicating whether that institution would support or not support the warranty. So, for example, Asay assumes that a single server can be trusted by the parties to a transaction, whereas here a plurality of institutions are involved, each of which may be trusted by, or have a relation with, one party or another. Thus, the claimed method may resolve this trust issue by one institution receiving from another institution information indicating whether that institution would support or not support the warranty.

With respect to claim 3, Applicant submits that Asay fails to disclose a method for aiding a plurality of different transactions carried out electronically between a plurality of

parties comprising, *inter alia*, sending first electronic information from the institution to another institution, the first electronic information including identification information regarding party A and information about the nature or content of the specific transaction and receiving second electronic information to the institution from the other institution, the second electronic information including information about the nature or content of the specific transaction as recited in independent claim 3.

As similarly discussed above, Asay simply discloses a system and a method utilizing a single institution, or server. In contrast, the claimed method facilitates processing of a warranty in an infrastructure having a plurality of institutions to enable one institution to send identification information regarding a party to a transaction and information about the nature or content of the transaction to another institution and receive information about the nature or content of the transaction from the other institution. So, for example, Asay assumes that a single server can be trusted by the parties to a transaction, whereas here a plurality of institutions are involved, each of which may be trusted by, or have a relation with, one party or another. Thus, the claimed method may resolve this trust issue by one institution sending identification information regarding a party to a transaction and information about the nature or content of the transaction to another institution and receiving information about the nature or content of the transaction from the other institution so as to determine whether to provide a warranty or not.

Therefore, for at least the above reasons, the cited portions of Asay fail to disclose, teach or suggest all the features recited by independent claims 1-3. New claims 4-20 depend from independent claims 1-3, respectively, and are, therefore, patentable over Asay for at least the same reasons provided above related to claims 1-3, and for the additional features recited therein. As a result, Applicant respectfully submits that the rejection under 35 U.S.C. §102(e) of claims 1-3 in view of Asay should be withdrawn and the claims allowed.

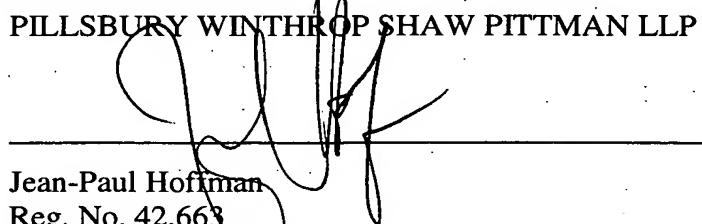
All objections and rejections having been addressed, it is respectfully submitted that the present application is in condition for allowance. If questions relating to patentability remain, the Examiner is invited to contact the undersigned to discuss them.

FRANKEL ET AL. - 10/042,335
Client/Matter: 061047-0282618

Should any fees be due, please charge them to our deposit account no. 03-3975, under our order no. 061047/0282618. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced deposit account.

Respectfully submitted,

PILLSBURY WINTHROP SHAW PITTMAN LLP



Jean-Paul Hoffman
Reg. No. 42,663
Tel. No. 703-770-7794
Fax No. 703-770-7901

JGH
P. O. Box 10500
McLean, VA 22102
(703) 770-7900